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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,519	07/13/2001	Satoshi Nakano	KON-1666	3475
20311	7590	07/14/2004	EXAMINER	
MUSERLIAN AND LUCAS AND MERCANTI, LLP 475 PARK AVENUE SOUTH NEW YORK, NY 10016			SCHWARTZ, JORDAN MARC	
			ART UNIT	PAPER NUMBER
			2873	

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant(s)

09/905,519

Applicant(s)

NAKANO, SATOSHI

Examiner

Jordan M. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-11, 13, 15, 16, 18, 19 and 21-23 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 21-23 is/are allowed.
6) ☒ Claim(s) 1-3, 5-11, 13, 15, 16, 18 and 19 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5-11, 13, 15, and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Tucker patent number 6,102,539.

Tucker reads on these claims by disclosing the limitations therein including the following: an optical element (abstract, column 2, lines 44-54 with the most object lens of the laminate as the “optical element”) comprising a base material consisting of a lens (column 2, lines 44-54 re the base material of this optical element consists of a lens); a surface layer formed on at least one of the surfaces (column 2, line 44 re “the adhesive” is between the lens elements and is therefore “formed on at least one of the surfaces” of the lenses and since it is formed on the surfaces of each of the lenses then it is a “surface layer”). Tucker further discloses that the adhesive layer includes a UV absorber to absorb substantially all radiation up to 400 nm (column 4, line 60) as well as the adhesive layer including a dye to provide selected transmission characteristics to reduce the transmission of light including the 420-680 nm range (column 3, line

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14 and Figures 1-2). Since the base material (the most object side lens) is not disclosed as absorbing radiation then the reflectance of the layer will inherently be less than the reflectance of the base material surface, this being based upon it being disclosed that the layer absorbs and reduces light transmission in light ranges that include 280-315 (i.e. "substantially all radiation up to 400nm") and 420-680 nm. Tucker further discloses the lens in an eyeglass (abstract). Since the layer is an adhesive between two lenses (abstract) then, in reference to the most object side lens of the laminate, the adhesive is formed on an image side surface (eye side surface) of this lens. Furthermore, since "the lens" is the most object side lens of the laminate, then the layer is being formed on the most image side entire surface of "the lens". Since the adhesive is minimizing light rays and is formed on the image side of the optical element, it will inherently minimize the rays entering from the image side of this lens. Furthermore, since it is an adhesive joining the two lenses then it will inherently be on the entire surface of this lens. The layered adhesive of Tucker would inherently include a substantially inorganic material, this being reasonably based upon Tucker disclosing that the layering can include a dye to impart the transmission characteristics (column 5, lines 11-37) and it is well known in the art of lenses that dyed lenses include the use of inorganic substances. It is believed that the adhesive of Tucker would inherently have the surface resistance as claimed, this being reasonably based upon the materials and method of forming the adhesive as set forth in Tucker. Tucker further discloses the lens including a polarizing film (column 5, lines 38-45). Therefore, the polarizing film can be considered the "base material" and it

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would be inherently providing the selective absorptivity as set forth in claims 8-9.

Tucker further discloses the layering can have plural layers (column 2, lines 55-67); and that the layer can comprise a conductive or metallic layer (column 5, line 20).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tucker patent number 6,102,539.

Tucker discloses as is set forth above but discloses the adhesive on just one of the surfaces of the lens. However, it is well known in the art of polarizing lenses that such lenses can be formed by stacks of polarizing sheets on both surfaces of the substrate being attached by an adhesive. Having the adhesive on both surfaces would inherently impart the same reflectance properties to both surfaces and would therefore inherently satisfy the limitations of claims 16 and 18. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the luminous properties and differences in wavelengths between the two surfaces as set forth in claims 16 and 18 since it is well known in the art of polarizing lenses that such lenses can

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be formed by stacks of polarizing sheets on both surfaces of the substrate being attached by an adhesive and having the adhesive on both surfaces would inherently impart the same reflectance properties to both surfaces and would therefore inherently satisfy the limitations of claims 16 and 18.

Allowable Subject Matter

Claims 21-23 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: with respect to the allowable subject matter, none of the prior art either alone or in combination disclose or teach of the claimed combination of limitations to warrant a rejection under 35 USC 102 or 103. Specifically, with reference to independent claim 21, none of the prior art either alone or in combination, disclose or teach of the claimed optical element specifically including, as the distinguishing feature in combination with the other limitations, the claimed transparent conductive layer containing indium oxide and the reflectance of a surface of the formed layer for all light rays in the wavelength regions as claimed smaller than a reflectance of a surface of the base material. Specifically, with reference to independent claim 22, none of the prior art either alone or in combination, disclose or teach of the claimed optical element specifically including, as the distinguishing feature in combination with the other limitations, the claimed luminous transmittance of the layer as 90% or more and the reflectance of a surface of the formed layer for all light rays in the wavelength regions as claimed smaller than a reflectance of a surface of the base material. Specifically, with reference to independent claim 23, none of the prior art either

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alone or in combination, disclose or teach of the claimed optical element specifically including, as the distinguishing feature in combination with the other limitations, the claimed spectral transmittance of the layer for all light rays in a wavelength region of 400 nm to 700 nm as 98% or more and the reflectance of a surface of the formed layer for all light rays in the wavelength regions as claimed smaller than a reflectance of a surface of the base material.

Response to Arguments

Applicant's arguments filed April 21, 2004 have been considered but, with respect to the rejected claims set forth above, they are not persuasive. Applicant is now claiming that the layer is formed on the most image side surface of the lens. However, as stated in the rejection above, the "lens" can be considered as just the most object side lens of the laminate of Tucker. Therefore, the layer is formed on the most image side entire surface of this lens and is therefore "on the most image side entire surface of the lens".

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory

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period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (571) 272-2337. The examiner can normally be reached on Monday to Friday (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached at (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'JMS', with a large, stylized loop at the end.

Jordan M. Schwartz
Primary Examiner
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July 8, 2004